

## **REMARKS**

The Office Action mailed on July 17, 2007 has been given careful consideration by applicant. Reconsideration of the application is respectfully requested in view of the comments and amendments herein.

### **The Office Action**

Claims 1-8, 11, and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 1-8, 11, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Kazily et al (U.S. 6,621,589) in view of Heartling (U.S. 6,874,034).

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Kazily et al (U.S. 6,621,589) in view of Johnson (U.S. 5,930,350).

### **Claim 15**

The Examiner rejected Claim 15 on that it includes a new matter, "an electrophotographic printer serving as the target device for receiving the print job, wherein the electrophotographic printer further includes; an imaging and exposing station; a photoreceptor; a developing station; a transferring station; and, a fusing station".

Applicant respectfully submits that the electrophotographic printer is not a new matter. Original Claim 15 literally discloses the element.

Applicant further submits that Claim 15 meets the written description requirement. It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. (Please see MPEP 2163.I). There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96. (Please see MPEP 2163.II.A). Consequently, rejection of an original claim for lack of written description should be rare. (Please see MPEP 2163.II.A).

To perfect the application, Applicant adds a new paragraph between original Paragraph [0038] and Paragraph [0039]. The new paragraph is near-literally based on original Claim 15, and no new matter is introduced. Under MPEP 2163.06.III, the claims

as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.

Applicant appreciates the Examiner's position that, as noted by the Office Action mailed on June 22, 2005, the limitation of an electrophotographic printer including an imaging and exposing station, a photoreceptor, a developing station, a transferring station and a fusing station, is novel over the prior art.

As such, Applicant respectfully submits that Claim 15 is patentable.

### **Claims 1-8, 11, and 13-14**

Likewise, the Examiner rejected Claims 1-8, 11, and 13-14 on that they all include a new matter, that is, "an electrophotographic printer serving as the target device for receiving the print job, wherein the electrophotographic printer further includes; an imaging and exposing station; a photoreceptor; a developing station; a transferring station; and, a fusing station".

Claims 1 and 6 are directed to printing systems; while claims 15, 11 and 14 are directed to printing methods. The systems and methods are intertwined in Applicant's compact application. All the figures, i.e. Figures 1-3, teach or suggest that the printing systems can be used to carry out the printing methods, and the printing methods can be embodied using the printing systems.

The electrophotographic printer is not a new matter, because a skilled artisan would appreciate that Applicant was in possession of the invention as claimed on or before the filing date.

Claim 1, 6, 11 and 14 are supported in the specification through express, implicit, or inherent disclosure.

Under MPEP 2163.I.B, "there is no *in haec verba* requirement" for "newly added claim limitations..." The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement. (Please see MPEP 2163.02)

“If the application as filed does not disclose the **complete structure (or acts of a process)** of the claimed invention as a whole, determine whether the specification discloses other relevant identifying characteristics sufficient to describe the claimed invention in such full, clear, concise, and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention”. (MPEP 2163.II.A.3.a.i)

“An applicant may also show that an invention is complete by disclosure of sufficiently detailed, **relevant identifying characteristics** which provide evidence that applicant was in possession of the claimed invention, i.e., complete **or partial structure**, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed **correlation between function and structure**, or some combination of such characteristics”. (MPEP 2163.II.A.3.a)

“By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter”. (Please see MPEP 2163.07.a)

Again, Applicant appreciates the Examiner’s position that, as noted by the Office Action mailed on June 22, 2005, the limitation of an electrophotographic printer including an imaging and exposing station, a photoreceptor, a developing station, a transferring station and a fusing station, is novel over the prior art.

As such, Applicant respectfully submits that Claims 1-8, 11, and 13-14 are all patentable.

### **Claims 16, 20 and 23**

In the July 17, 2007 Office Action, the Examiner conceded that Al Kazily does not teach an agent service on the print server for receiving and at least temporarily retaining the print job attributes communicated from the client, wherein the plurality of print job attributes include distribution information including a first recipient name and a first telephone number associated with sending the print job as a fax to the first recipient.

Examiner reasons, however, that combining Johnson with Al Kazily would have been obvious to a person of ordinary skill in the art at the time of the invention.

Applicant respectfully traverses this position, and argues that Al Kazily and Johnson are not combinable. Al Kazily teaches a method of managing machine-to-machine communication, while Johnson teaches how to facilitate person-to-person communication by way of speed dialing.

There is no motivation for combining the two references, since neither reference expressly or implicitly suggests combining the inventions. Al Kazily teaches a central print system which distributes print jobs based upon user specified print job attributes. Al Kazily does not disclose including a telephone number or fax information in the print attributes. Furthermore, Al Kazily does not discuss any use of a telephone or fax machine in conjunction with the print system. Consequently, there is no need to combine any system of managing telephone or fax numbers, such as the one in Johnson, with the Al Kazily print system.

Conversely, Johnson teaches a system and method for automatically configuring speed dial settings on a telephone. The system includes a speed dial database 122 which stores user information after a user sends a communication to a recipient. The sender's phone number is then programmed as a speed dial setting on the recipient's telephone. The system in Johnson is concerned with the ID and phone number of the sender, not the delivery and attributes of the communications themselves. As such, there is no motivation to combine any print system, such as the one in Al Kazily, with the speed dial system in Johnson.

## **CONCLUSION**

For the reasons detailed above, it is submitted that Claims 1-8, 11, 13-24 are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment After Final. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

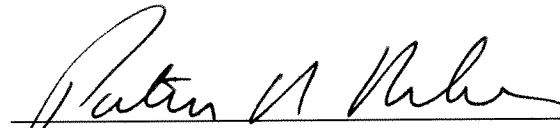
In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Patrick R. Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
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Date

10/17/07



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